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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,191	12/21/2001	Philippe Collas	50195/003002	4902

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101 FEDERAL STREET  
BOSTON, MA 02110

EXAMINER

WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 01/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

10/032,191

## Applicant(s)

COLLAS ET AL.

## Examiner

Joseph T. Voitach

## Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-42 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

This application filed December 21, 2001 claims benefit to provisional application 60/258,151, filed December 22, 2000.

Claims 1-42 are pending and currently under examination.

#### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, drawn to a method of cloning a non-human mammal comprising incubating a permeabilized cell in a reprogramming media to form a reprogrammed cell, classified in class 800, subclass 21.
- II. Claims 16-28, drawn to a method of cloning a non-human mammal comprising contacting a donor nucleus having less than four sets of homologous chromosomes with a reprogramming media, classified in class 800, subclass 20.
- III. Claims 29 and 30, drawn to a method of cloning a non-human mammal comprising inserting a cell nucleus into an oocyte to form a first embryo, contacting one of more cells of the first embryo with one or more cells of a second embryo wherein at least one of the embryos is a compaction embryo, classified in class 800, subclass 20.

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- IV. Claims 31 and 32, drawn to a method of cloning a non-human mammal comprising contacting a donor nucleus with a reprogramming media to form a chromosome mass, inserting the chromosome mass into an oocyte to form a first embryo, contacting one of more cells of the first embryo with one or more cells of a second embryo, classified in class 800, subclass 20.
- V. Claims 33 and 34, drawn to a method of cloning a non-human mammal comprising incubating a permeabilized cell in a reprogramming media to form a reprogrammed cell, inserting the reprogrammed cell into an oocyte forming a first embryo, contacting one of more cells of the first embryo with one or more cells of a second embryo forming a third embryo, classified in class 800, subclass 20.

Claim 35 is generic and depends on claims 31 and 33 and will be examined to the extent it comprises the elected invention. Claims 36-39, 40, 41 and 42 are generic and depend on claims 29-31 and 33 and will be examined to the extent it comprises the elected invention.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to methods which comprise specific and different method steps and

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different materials to practice. While each is generally drawn to a method of cloning a non-human mammal each method sets forth a series of unique method steps using different starting materials and each resulting in unique intermediate products. Further, even though the preamble of all the claims states that the method is directed to cloning a non-human mammal these unique method steps and intermediate products may result in a unique final product. For example, the method of group I results in a mammal derived from only one cell, wherein the mammal of group III results in a mammal with cells from at least two different cells. Clearly, the methods of groups III-V will not result in a cloned non-human mammal because such a chimeric mammal does not exist until created by an artificial method such as that set forth in the claims. With respect to groups I and II, the methods of group II encompass only cells having four or less homologous chromosomes and forming a chromosome mass where group I encompasses cells, thus chromosome type and number, from any source.

Because these inventions are distinct for the reasons given above and the search required for Groups I-V is not required and different for one another, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (571) 272-0739.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (571)272-0734.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (571)272-0532.

Joseph T. Woitach



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